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# United States Court of Appeals for the Ninth Circuit.

No. 16132.

JAMES MOON ET AL.,  
PLAINTIFFS, APPELLANTS,

*v.*

CABOT SHOPS, INC., ET AL.,  
DEFENDANTS, CROSS-APPELLANTS.

## BRIEF FOR CROSS-APPELLANTS.

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## BRIEF FOR CROSS-APPELLANTS.

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### Statement of Jurisdiction.

This case arises on appeal from the judgment of the United States District Court, Southern District of California, Central Division. In that Court plaintiffs James Moon, Edmond M. Wagner and Philip Subkow brought an action against defendants Cabot Shops, Inc., and Howard Supply Company for infringement of United States Letters Patent No. 2,671,537. Jurisdiction of the District Court arose under 28 U.S.C. § 1338(a); jurisdiction of this Court arises under 28 U.S.C. § 1292(4). There is no dispute as to jurisdiction.

### Statement of the Case.

After full trial the District Court entered judgment for defendants (R. p. 90). In that judgment the Court ruled

that the claims of the patent in suit were valid but that none of the claims in suit had been infringed by defendants.

Plaintiffs below have appealed from the judgment (R. p. 92), and defendants below have cross-appealed from that portion of the judgment which ruled that the claims of the patent in suit were valid (R. p. 93).

This cross-appeal, therefore, challenges the judgment of validity and raises questions as to whether or not the District Court correctly analyzed and applied evidence offered on behalf of defendants for the purpose of proving that the claims were invalid.

### **Specification of Errors.**

1. The District Court erred in failing to rule that the claims of the patent in suit are invalid as being for nothing more than a collection of elements old in the art combined in an obvious manner to produce an obvious result.

2. The District Court erred in failing to rule that the alleged invention of the patent in suit was described in printed publications published more than one year prior to the filing of the application for the patent in suit.

3. The District Court erred in failing to rule that the claims of the patent in suit are invalid for lack of invention over prior art devices.

### **The Patent in Suit.**

The patent in suit, No. 2,671,537 (R. p. 638), was issued to the plaintiff Moon on March 9, 1954, on an application filed in the Patent Office June 28, 1948. It relates to portable drilling and servicing rigs primarily useful for drilling oil wells and for pulling and inserting oil-well tubing.

In earlier times a derrick was constructed at the location of a well, used in connection with drilling operations, and

left permanently in position so that it might be used later on, from time to time, in connection with servicing operations, *i. e.*, pulling and inserting tubing, bailing, etc. These derricks were expensive eyesores. Hence there were developed a number of types of portable derrick units which could be collapsed into horizontal position and carried from one location to another. Examples of such units, or rigs, appear in such prior art patents as:

McEwen,	No. 2,331,558 (R. p. 898 <i>et seq.</i> ).
Cardwell,	No. 2,276,224 (R. p. 860 <i>et seq.</i> ).
Franks,	No. 2,215,920 (R. p. 854 <i>et seq.</i> ).
White,	No. 2,204,713 (R. p. 658 <i>et seq.</i> ).

By way of example, the McEwen patent shows a derrick 10 having telescoping sections and a hydraulic jack 22 for rotating the derrick from horizontal to vertical position about a hinge point 9 mounted at the rear end of a chassis 2 drawn by a truck or tractor 1 containing an engine and a space for a driver. The derrick was driven over the road while in horizontal collapsed condition (Fig. 1) and erected for operation (Fig. 3) at the site of a well. The White patent shows a similar rig in which, however, the derrick is erected by a screw 9 operating a cross-head 7 and pitman 4.

The patent in suit (R. p. 638) shows a similar rig with the same elements somewhat reversed. As shown in Fig. 1, there is a telescoping derrick 19 and a hydraulic jack or jacks 28 for rotating the derrick from horizontal to vertical position. However, the derrick rotates about a hinge point 17 adjacent the front of the cab, above the driver, the bottom of the derrick being disposed at the front of the chassis. Moreover, the engine 4 is disposed at the rear of the chassis.



Moon originally sought a patent covering this simple rearrangement of the old elements. Cancelled claim 6 is an example of what he considered his invention to be; it reads as follows (from R. p. 502) (Appendix, p. 35):

“6. A portable drilling derrick, comprising a vehicle chassis, front and rear wheels for said chassis, the ends of the legs of said derrick protruding ahead of said front wheels and the top end of said derrick being positioned toward the rear of said chassis, a hinge on said derrick, said hinge being mounted at the front end of said chassis, and means positioned on said chassis to rotate said derrick about said hinge point to move said derrick to an erect position.”

The Patent Office rejected all such claims, primarily because they expressed nothing more than a simple reversal of the parts shown in such patents as McEwen. Moon fought hard; he filed lengthy arguments and affidavits, and his attorney interviewed the Examiner, getting nowhere (Appendix, pp. 51-55).

Finally, the Examiner was persuaded to allow claims limited to a construction in which the legs of the derrick straddle the driver's position, as best shown in Fig. 3 of the patent in suit. Here it appears that the rear legs 18 of the derrick pass downwardly in a plane which includes part of the steering wheel and the driver's seat. The file wrapper does not reveal why that feature impressed the Examiner, since the discussion of it was at an oral interview. All we have for guide is Mr. Subkow's statement appearing at page 48 of the file wrapper (also R. p. 503) (Appendix, p. 51):

“One of the features which the Examiner indicated as possibly carrying the claim over the then cited ref-



erences was the straddling of the cab by the derrick when erected.”

In defendants’ rigs the legs do not straddle the driver’s position; the hinge is mounted at the upper front extremity of the truck or cab (*cf.* Ex. 59, R. p. 773, and the photographs, Ex. AB, R. p. 990, AF, AG).

Plaintiffs are in a hopeless dilemma. If the claims of the patent in suit are narrowly interpreted, they are not infringed, as the District Court held. If they are interpreted broadly enough to cover defendants’ structures, then they are invalid as calling for a simple and obvious reversal of the parts of the old McEwen and White devices.

We now have established that Moon admitted that his invention was not in simply reversing the derrick and engines; he admitted that when he cancelled all the broad claims and accepted claims strictly limited to a rig in which the legs of the derrick straddled the driver’s position. Therefore we turn to a consideration of whether the addition of that feature was patentable.

### **Making the Legs Straddle the Driver’s Position was Not Invention.**

The Patent Office ruled that mounting the derrick for rotation at the front of the chassis was not inventive. That seems only common sense. But the Patent Office ruled that *it was* invention to have the legs of a front-mounted derrick straddle the cab or driver’s position. Why? We shall never know the answer, since the file wrapper does not tell us. Plaintiff offered no evidence to explain it. When Moon himself designed and built rigs, the legs did not straddle the cab (see Ex. 33, R. p. 682; Ex. 34, R. p. 683; Ex. 35, R. p. 684; Ex. G). Mr. Moon testified at his deposition:

“Q. Did you ever build a rig with the hinge point directly over the steering wheel?

“A. No.

“Q. Why not?

“A. First we didn't consider it desirable from a safety standpoint; we felt the cab would be too vulnerable to damage when it was located closer to the well-head than if we would put the hinge point directly forward of the cab. Second, in the design that we worked out, because of the wheel loadings we were trying to achieve we found it more desirable to move the derrick slightly forward.”

Our position on this point may be summed up as follows:

1. Moon's patent was issued only after the claims were limited to a rig in which the derrick legs straddle the cab.
2. Neither Moon nor defendant built a rig in which the legs straddled the cab.
3. There is no evidence to show that straddling the cab was useful, desirable or advantageous.
4. Hence the claims do not define invention.

In support of our position we rely upon *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, and *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F. 2d 492 (C.A. 9).

### **The Claims are Invalid by Reason of the Waldrip Advertisements.**

Moon was vice-president of Waldrip Engineering Company (R. p. 216), which manufactured units of the type here in question. In the spring of 1947 that company placed advertisements in trade journals, some of which are in evidence as follows:

R. p. 370, Ex. M

Oil Weekly, May 5, 1947, p. 58 (Appendix, p. 26).

R. p. 371, Ex. N

The Oil and Gas Journal, May 10, 1947, p. 104 (Appendix, p. 27).

R. p. 371, Ex. O

The Petroleum Engineer, June 1947, p. 192 (Appendix, p. 29).

R. p. 372, Ex. P

The Petroleum Engineer, May 1947, p. 234 (Appendix, p. 31).

R. pp. 372, 385, Ex. Q

The Petroleum Engineer, Apr. 1947, cover.

These publications were in fact published more than one year before the filing of the application for the patent in suit, *i. e.*, June 28, 1948.

35 U.S.C. § 102, reads in part as follows:

“A person shall be entitled to a patent unless—

“(a) . . .

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . .”

If the advertisements disclose the structure of the patent in suit, the patent is clearly invalid. There is no dispute as to the fact or dates of the publications. The controversy here is whether or not the disclosures of the publications

are essentially of the same structure as that of the patent. The District Court held (R. p. 89):

“5. It does not clearly appear from the evidence that the devices described in the printed publications embody the invention of the patent in suit, the details not being apparent from the advertisements.”

Most unfortunately the District Court did not specify *what* “details” were not apparent. We contend that every material element is clearly shown or described.

Let us take, for example, claim 1 of the patent in suit and compare it with Ex. P (Appendix, p. 31):

*Claim 1*

*Ex. P*

“A portable derrick” comprising a chassis

Obvious from picture and text; any vehicle has a chassis

front wheels mounted on axle positioned adjacent the rear end of the chassis

obvious from drawing

a driver's position with steering and motive power controls positioned adjacent the front end of said chassis and extending forward of the front axle

see cab and steering wheel, upper picture and position of front axle relative thereto

a collapsible and extensible derrick

“Waldrip telescoping derrick” (in text of advertisement)

pivottally mounted on the chassis to move from a rest position on said chassis

see upper picture for “rest position”

with the top end of the derrick positioned rearwardly of said chassis and the bottom of said derrick being positioned on said chassis toward the front end of said chassis

comparison of upper and lower pictures shows top end of derrick is at rear when lowered; lower end of derrick is at front of chassis

*Claim 1**Ex. P*

spaced two front and two rear legs for the derrick

cross bracing between said legs with a free area between a portion of the legs

said derrick comprising a lower section and an upper section, means for moving the upper section relative to the lower section to extend and to collapse said derrick

a hinge on said derrick positioned near the bottom end of said derrick  
said hinge also positioned on said chassis intermediate the forwardmost limits of said chassis and the front axle and above said driver's position

and means for rotating said derrick about said hinge to an erect position adjacent the front end of said chassis

said means including a rotation power transmitting member connected to said derrick at a point on said derrick spaced from said hinge, said transmitting member transmitting rotated power to said derrick to rotate said derrick about said hinge

obvious; *cf.* Groner test. (R. p. 406: "Q. Have you ever seen a two-legged derrick? A. No, sir. I have not.")

obvious and necessary

There must be such a free area; otherwise how could derrick move from position in upper picture to straddle the cab as shown in the lower picture?

"Waldrip telescoping derrick"; also clear from pictures

If you compare upper and lower pictures, it is evident that derrick has been pivoted about a point over the steering wheel just as called for by claim

A comparison of the two pictures shows a hydraulic jack, which in the upper picture is shown in collapsed position back of the cab, and in the lower picture is shown extended

It is obvious from the pictures that the jack is connected to the derrick back of the hinge



*Claim 1**Ex. P*

and a load transmitting connection between said member and said chassis

The lower end of the jack must of necessity be connected directly or indirectly to the chassis at its lower end

said connection being positioned on said chassis between said front and rear axles

Here again it is obvious that the lower end of the jack is mounted between the axles

lower portions of said legs being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position

A glance at the lower picture shows definitely that the legs of the derrick clear the cab

and said lower leg portions and said hinge being located with respect to the longitudinal axis of said chassis to cause a portion of the driver's position to enter said free area and the lower rear leg portions to straddle said driver's position when the derrick is in said erect position

Here again the specific relationship is clearly shown in the lower picture

We reproduce on an adjoining page (at the top) Fig. 1 of the patent in suit. Beneath it we show the picture from Exhibit O. We make three specific contentions:

1. Even the casual observer will recognize that the picture in Exhibit O represents the same apparatus shown in Fig. 1 of the patent.

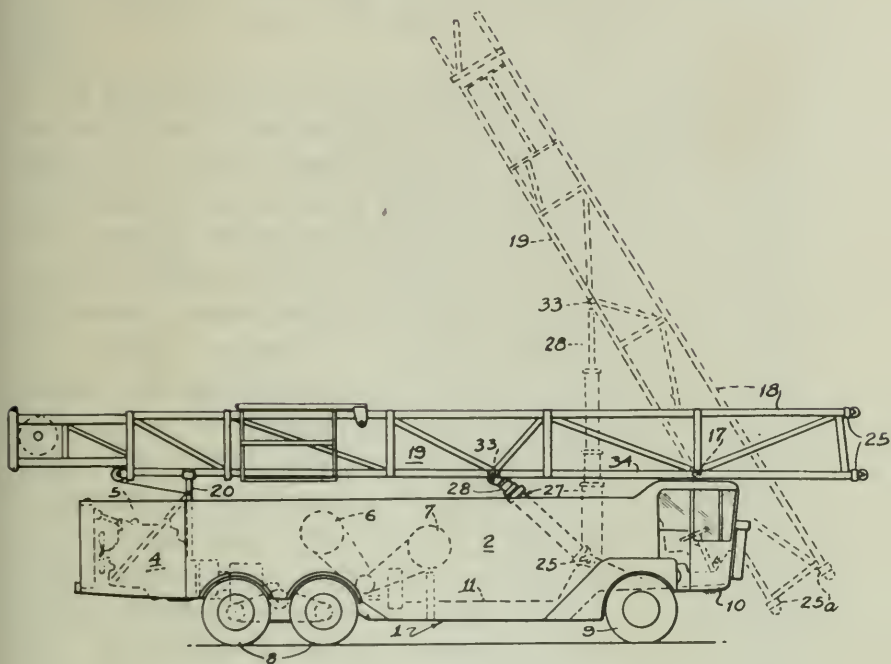
2. A competent engineer would recognize that the showing of Exhibit O is the same device shown in Fig. 1 of the patent, even though the engineer has had no specific experience in the field.

3. An engineer having experience in the specific field would recognize that Exhibit O shows precisely the equipment disclosed in the patent.

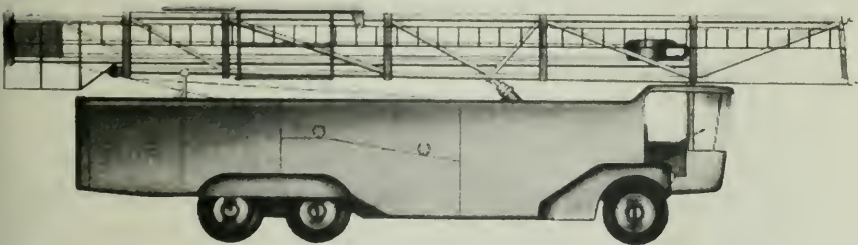
With respect to the first contention we say simply that, if you read the advertisement and look at its pictures, you

FIG. 1 OF THE PATENT IN SUIT

FROM EXHIBIT I



PICTURE FROM EXHIBIT ( )



FROM EXHIBIT O





have the clear and distinct impression that they show and describe exactly what is found in the patent in suit. That is, of course, a subjective proposition, and we can only trust that the Court will gain the same impression we have.

We have proved the truth of the second contention. In the course of preparing for trial we recognize that, if an expert in the field studied the patent and studied the advertisements, he would be subject to attack on the ground that, when he interpreted the exhibits, he would be unconsciously influenced by his study of the patent. Therefore defendants' counsel called Mr. Stanley Groner, a mechanical engineer engaged in design work on aircraft fuel pumps. He had never seen the patent in suit, nor had he seen any of the equipment used to drill and service oil wells. He testified solely on the basis of his examination of Exhibits M, N, O, and Q (R. pp. 387 *et seq.*). His testimony proves that a competent engineer will derive from these exhibits information which is substantially the same that he would derive from an examination of the patent in suit. Mr. Groner is the only witness in any way connected with this case who could interpret Exhibits M-Q without any shadow of bias or prior knowledge which would influence him one way or the other.

Mr. Frank Purdum, a consulting petroleum engineer, had had many years of experience with all kinds of oil-field equipment. He testified that the disclosure of Exhibits M-Q corresponded exactly with the disclosure of the patent (R. pp. 375 *et seq.*).

Mr. Groner and Mr. Purdum testified that the structure of the patent in suit had been disclosed by Exhibits M-Q. Plaintiffs did not offer a word of testimony to dispute the testimony of Messrs. Groner and Purdum. It is perfectly obvious that, if the ordinary worker in this art would *not* find in Exhibits M-Q what he finds in the patent in suit,

there would have been witnesses produced by the plaintiffs in support of such a proposition. The absence of any such witness is extremely significant.

### The Requirements of the Statute Regarding Prior Publications.

35 U.S.C. § 102(b) is in part as follows:

“A person shall be entitled to a patent unless—

. . . . .

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States, . . .”

The first paragraph of section 112 of Title 35 reads as follows:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

Plaintiffs contended in the Court below that a publication such as any one of Exhibits M-Q does not invalidate a patent unless *every* detail of the disclosure of the patent is to be found in the publication. We do not accept that

contention. It seems obvious to us that the proper test should be whether or not the publication is sufficient to carry the essential message to the art as to the nature of the alleged invention. The testimony of Messrs. Groner and Purdum certainly shows that the publications met that test.

It is also to be noted that, when it comes to the sufficiency of the patent application, the gist of the requirement of section 112 is that the disclosure be such "as to enable any person skilled in the art . . . to make and use the same." A review of the testimony of Groner and Purdum certainly reveals that the publications did in fact contain sufficient material to enable a man skilled in the art to make and use the invention.

As was stated by the Court in *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F. 2d 492, 497 (C.A. 9):

"The publication does not show exact detailed construction, nor attempt to specify the strength of the various parts; neither do any of the patents in suit. . . . The same rules as to the sufficiency of the description in a patent apply to the printed publication. 48 C.J. § 52, pp. 49, 50, 51."

Note here that Exhibit M (Appendix, p. 26) tells us that the Waldrip unit "has a net hook horsepower of 117 and will start 4000 feet of 2½ inch tubing off bottom at 90 feet per minute with three lines strung on the block"; also: "This light-weight unit complies with California highway regulations when equipped with Waldrip-Western 65 foot 60,000 pound or 90,000 pound hook load capacity telescoping derrick." None of that information appears in the patent, and it can truly be said that the published advertisements give a more specific description than does the patent.

Since the District Judge did not specify which "details" of the invention were not "apparent from the advertisements," we obviously cannot comment to any great extent. It would be idle to speculate as to which detail or details were not apparent to the District Judge. We can only say that in our best judgment there is no detail of any significance which is not found in the advertisements.

### **The Filing Date of the Patent Application Cannot be Carried Back.**

In his findings of fact, conclusions of law and judgment, page 89, the District Judge held:

"7. The application of the patent in suit does not contain any caveat on the face of the issued Letters Patent giving notice of any claim to any filing date earlier than the filing date of the patent in suit."

On page 90 of the record he further ruled:

"3. Plaintiffs are not entitled to carry the effective filing date of the patent in suit to February 24, 1948, the filing date of the application Exhibit 46."

Plaintiffs urge that Exhibits M-Q were not publications published more than a year before the filing date of the application for the patent in suit by reason of the fact, they claimed, that the invention was disclosed in a prior application of Moon and that Moon was entitled to the benefit of the earlier filing date. That subject involves section 120 of Title 35:

"§ 120. Benefit of earlier filing date in the United States.

“An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and *if it contains or is amended to contain a specific reference to the earlier filed application.*” (Emphasis ours.)

The fact is that the application for the patent in suit contained no reference to any earlier application of Moon; furthermore, the application was never amended to contain any reference to any earlier application of Moon. The District Court held, in effect, that a patentee is not entitled to the benefit of any earlier filed application unless the specific language of section 120 has been complied with. That proposition seems so logical and unassailable that we feel no further comment is needed.

### **The Patent in Suit is Invalid as Lacking Invention over the Prior Art.**

On this phase of the case we contend that the patent in suit is invalid for the reason that it discloses nothing rising to the dignity of an invention, in view of three prior art patents. We refer first to the patent to Morton, No. 966,346, comparing it to Exhibit S and beginning at page 781 of the record. The Morton patent, like the patent in suit, deals with the problem of a telescoping tower which



can be carried on a vehicle in flat horizontal position and then erected into vertical position at a desired site. Mr. Morton was not dealing with oil-well equipment; he was dealing specifically with a fire-fighting tower. It is perhaps most instructive to start with Fig. 10, in which the telescoping tower is shown in one of its possible positions of operation. Here we find a telescoping tower of three sections, 43, 44 and 45. It is mounted on a chassis *a* including front wheels and rear wheels, and there is provided a pneumatically operated jack or lever 50 by means of which the tower can be raised from a flat collapsed position on the chassis to the elevated position shown in Fig. 10. If now we look at Fig. 2 (R. p. 781), we see that the tower section 43 is flat on the chassis *a*, the tip ends of the other two sections 44 and 45 appearing at the right-hand end of the drawing. There is also a pneumatic cylinder 195 in which there is a piston which operates the elevating lever 50. When Figs. 2 and 10 are compared, it is quite evident that the elevating mechanism is of the same genus as the jack 28 in the patent in suit. It will also be noted that there is a driver's seat 400 adjacent to the bottom of the tower, and shafts are shown in part connected to the axle at the front wheel *b*.

The Morton patent was applied for in 1904, at a time when vehicles were drawn by horses rather than engines. Obviously it would not amount to invention in 1948 to substitute an engine for a horse. As a matter of fact, referring to Fig. 2 of the Morton patent there appears an engine 198 mounted *at the rear* of the chassis *a*. The engine 198 was provided, not for the purpose of propelling the vehicle but rather for driving the pump 196 which serves the hydraulic cylinder 195 used to actuate the elevating mechanism, but it certainly shows that it was old and well understood that an engine might be mounted at the rear of a vehicle.



It should be noted that the Morton apparatus has a hinge at the front about which the tower is rotated. The thrust on the lever 50 is transmitted to the chassis between the front and rear wheels. In short, all that would be necessary by way of modification of the Morton device to produce the device of the patent in suit would be to install the propelling engine at the rear and replace the tubular tower by the conventional telescoping derrick.

It may be objected on behalf of plaintiffs that the art of fire towers is not analogous to the art of portable oil-well derricks. Our answer to that is that the Patent Office cited fire-fighting apparatus against the Moon application, as shown by the Steck patent in Exhibit T-1 (R. p. 953). Moreover, Moon testified that he had himself designed fire-fighting equipment (R. p. 317). The significance of the Morton patent is that it demonstrates very clearly that a competent engineer faced with the problem of transporting a telescoping tower or derrick would solve that problem in the same basic way that appealed to Mr. Moon.

We turn now to a consideration of the Evans patent, beginning at page 880 of the record and forming part of Exhibit S. Of particular significance are Figs. 10 and 11. Here there is shown a chassis having front wheels 11 and rear wheels 12. The chassis has an engine 5 disposed over the rear wheels, just as in the Moon patent. Moreover, at the front of the device there is mounted a folding derrick 110, the upper half of which may be rotated rearwardly and downwardly until it lies flat, as shown at Fig. 10, in which position it is supported at its rear by a brace 120. Again, we do not assert that the Evans patent shows a device which, as it stands, could be usefully employed to service oil wells. It would have to be larger in every dimension. We do assert, however, that the Evans patent, like the Morton patent, shows the basic combination of a chassis, an engine, and a collapsible tower or derrick struc-

ture mounted at the front end of the chassis and adapted to be rotated into horizontal position for transport and also arranged to be rotated to vertical position at a desired location. Here again, a competent engineer adopted the same basic solution to the problem which Mr. Moon found attractive.

Finally we turn to the Downie patent, appearing at page 803 of the record. The apparatus shown in the Downie patent is, rather surprisingly, still in use in the oil fields, as Mr. Purdum testified (R. p. 413):

“The one thing of interest regarding this machine is that the same general type is still in use in drilling shallow wells and drilling wells in after rotary in several parts of the country. I saw one just the other day in operation.”

Here again we have a chassis with front wheels 3 and rear wheels 4, as clearly shown in Fig. 1. There is an engine mounted at the rear of the chassis and a tower mounted at the front of the chassis. It should be noted that the derrick or mast 13 is hinged at 12 to the posts 9, which are supported and braced adjacent the front end of the chassis, and the patent states (p. 2, line 42):

“The posts 9 have secured thereto by hinges 12 one end of a derrick or mast 13, such as is commonly employed in connection with well drilling machines, the hinges 12 permitting the folding of the mast down upon the vehicle so as to lie comparatively flat when the machine is being transported from place to place and the derrick is provided with braces 14 which may be connected by bolts 15 to brackets 16 upstanding from the posts 8.”

The Downie patent was applied for back in January, 1912, and, as might be expected, the device does not include a propelling engine. But with the knowledge of automotive equipment held by a competent engineer, in the period following the second World War, it certainly cannot amount to inventive genius to take from the Downie patent the concept of a collapsible derrick mounted at the front end, an engine mounted at the rear, and add to that the common propelling engine and cab found in the truck.

### Some Applicable Cases.

In *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 87 U.S.P.Q. 303; 340 U.S. 147, the Supreme Court held invalid the Turnham patent in spite of concurrent findings of the lower Court that the alleged invention had filled a long-felt want, as evidenced by its immediate acceptance in the industry, stating:

“The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts in the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test.”

In *Jungersen v. Ostby & Barton Co.*, 80 U.S.P.Q. 32; 335 U.S. 560, the Supreme Court held invalid the Jungersen

patent covering a lost wax process of casting precious metals. This patent had proved extremely important in the industry. Numerous licenses had been issued and the opinion of the Court below clearly shows that the patent had had massive impact upon the art; but the Court stated:

“Where centrifugal force was common as a means of introducing molten metal into the secondary mould, its use in an intermediate step to force molten wax into the primary mould was not an exemplification of inventive genius such as is necessary to render the patent valid. . . . Thus Jungersen employed in his claimed invention well-known skills and practices in a manner and for a purpose long familiar in the field of casting. His claimed improvement is therefore not patentable.”

In *Altoona Publix Theatres, Inc., v. American Tri-Ergon Corp.*, 24 U.S.P.Q. 308; 294 U.S. 477, the Supreme Court was considering an improvement relating to the reeling of sound track upon films, where the inventor had added a fly wheel to obtain uniform speed. The improved machine was novel and solved a long-recognized problem, but the Court held that, where the operating principle of a main patent is retained, and the so-called improvements fall within the reach of ordinary mechanical skill, there is no patentable invention.<sup>1</sup>

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<sup>1</sup> It is interesting to note that the Courts of other countries must wrestle with the same problems facing us here. Thus in Canada, MacLean, J., speaking for the Court in *Canadian Gypsum Co. Ltd. v. Gypsum, Lime & Alabastine Canada, Ltd.*, Ex. C.R. 187 (1931), stated:

“To support a valid patent there must be something more than a new and useful manufacture, it must have involved somehow the application of the inventive mind; the invention must have required for its evolution some amount of in-

Judge Hutcheson (C.A. 5) has written (14 Cornell Law Quarterly, pp. 274-288):

“Judges who have tried many patent cases, who have heard the testimony of experts, the one affirming the matter to be merely an advance in mechanical steps, the other to be invention of the highest order; the one affirming prior use, the other denying it; the one affirming it to be the flight of genius into new fields, the other, the mere dull trudging of an artizan, know that for a just decision of such causes no objective criteria can be relied on. They know well that there must be in the trier something of the same imaginative response to an idea, something of that same flash of genius that there is in the inventor, which all great patent judges have had, that intuitive brilliance of the imagination, that luminous quality of the mind, that can give back, where there is invention, an answering flash for flash.”

When the Moon patent here in suit is viewed in the light of the prior art, we contend that there is nothing disclosed in the patent which has the ring of invention about it. Surely to hinge a derrick for rotation at one end of a vehicle instead of the other is not an impressive step. Whether or not the derrick is arranged to clear the vehicle

---

genuity to constitute subject matter, or in other words invention. Fortunately the law does not authorize the granting of a monopoly for everything that is new and useful. The design of the patent law is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. If there is no novelty, there can of course be no inventive ingenuity, but if there is novelty in the sense required in the law of patents, it must be the product of original thought or inventive skill.”



or straddle a portion of it is an even more inconsequential point. We respectfully submit that the Moon patent contains no scintilla of inventive genius.

### **The Problem of Highway Legality.**

There was a mass of testimony at the trial offered by plaintiffs in an attempt to persuade the Court that Moon's alleged invention had solved the problem of making portable well-servicing rigs which would comply with the highway laws of the various states. These laws limit the weight per axle and limit the forward, rear and lateral dimensions of all vehicles using the highways. The patent itself says nothing whatsoever about the highway laws, nor was it written as one would write a patent application if the object of an invention had been to produce equipment which complied with the highway laws.

In any event, it is quite evident that Mr. Moon did not solve the problem posed by the highway laws. We refer in particular to the testimony of Mr. Hopper (R. pp. 331-332):

“Q. I would like to ask you about the problem of legality of the well servicing and drilling rigs, and ask whether in the light of your experience you have greater problems with drive-in equipment or with back-in equipment.

“A. No, I would say in general the problems are very similar.

“Q. Would you say that the problem of legality of this type of equipment is one which has been satisfactorily solved?

“A. No, that problem will be with us forever, as near as I can tell.”

Mr. Hopper is the Manager of shop operations for the Hopper Machineworks, Inc., present in Court under subpoena and having no connection with this suit, except for the fact that his company had taken a license under the Moon patent. Mr. Hopper is a man of vast experience in the field.

### Conclusion.

We have demonstrated, we trust, that the patent in suit is invalid for any one of three distinct reasons. We realize, however, that it is incumbent upon us to show that the District Court was clearly erroneous. Ordinarily we should take considerable pains to deal with the reasoning of the lower Court's opinion in an effort to show where the error or errors occurred. However, an examination of the findings of fact and conclusions of law shows very clearly that the District Court did not anywhere set forth its reasoning. We must therefore rest our case on the proposition that, when our three contentions are carefully examined, it is obvious that they are all completely logical and conclusive, the result being that a contrary ruling would be clearly erroneous.

To sum up, we say that our first proposition is that the patent in suit does not disclose anything but an obvious reversal of the parts of the prior art as evidenced by the McEwen patent (R. p. 898).

Our second proposition is that the patent in suit is obviously invalid by virtue of the fact that the alleged invention of the patent in suit had been shown and described in printed publications published more than a year prior to the filing date of the application in suit. We refer here to Exhibits M-Q (Appendix, pp. 26-31).



Our final position is that the patent in suit is clearly invalid, since it does not disclose anything which could be considered as a display of inventive genius over the old prior art devices disclosed in the Morton patent (R. p. 781), the Evans patent (R. p. 880) or the Downie patent (R. p. 803).

We therefore respectfully represent that that part of the judgment holding the patent valid should be reversed, with costs to cross-appellants.

LYON & LYON,

CHARLES G. LYON,

711 West Seventh St.,

Los Angeles, California.

KENWAY. JENNEY. WITTER & HILDRETH,

HERBERT P. KENWAY,

GEORGE W. CROWLEY,

24 School Street,

Boston, Massachusetts.

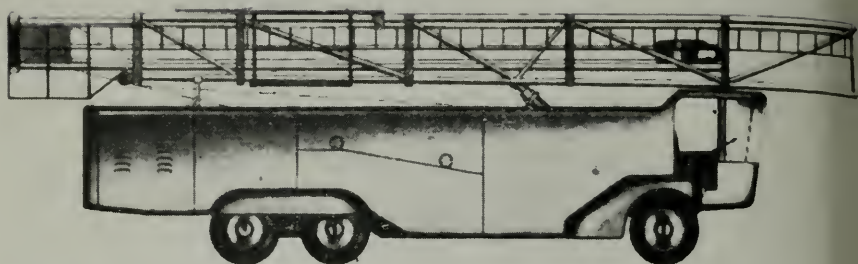
KENNETH W. BROWN,

77 Franklin Street,

Boston, Massachusetts.

## APPENDIX.

From Oil Weekly, May 5, 1947



## 5—Portable Servicing Rig

Model 321, self-propelled servicing and drilling rig, is designed to service wells to 4000 feet and to clean out, deepen and workover wells to 2500 feet. It has a net hook horsepower of 117 and will start 4000 feet of 2½-inch tubing off bottom at 90 feet per minute with three lines strung on the block.

The unit is comprised of a double drum hoist with single engine drive, torque converter or gear transmission, right-angle gear box and portable telescoping derrick of unusual design, all integrally mounted on a streamlined six-wheel chassis. Rotary countershaft with propeller shaft rotary drive and regular and automatic catheads are offered as accessory equipment. Speed of moving and erection has been a prime consideration in the design. The portable rig may be driven into the location nose

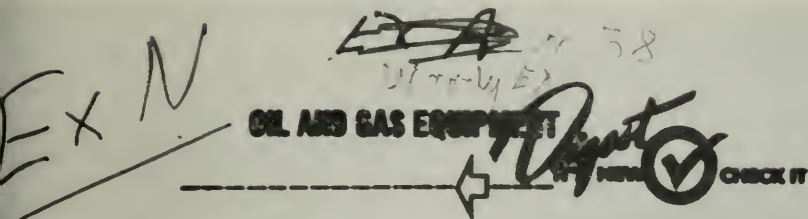
first instead of backing in. This provides easier, faster spotting at the well location.

Functional design provides balance with less weight, it is claimed. There is less load over the front wheels. Power controls are placed at the derrick level to allow the best possible operating vision. The motor, located at the rear of the unit, is easily accessible and completely enclosed by streamlined contour guards. It is available with gas, gasoline, butane or diesel engine and with a torque converter or gear box at the operator's option. This light weight unit complies with California highway regulations when equipped with Waldrip-Wester 65-foot, 60,000-pound or 90,000-pound hook load capacity telescoping derrick.

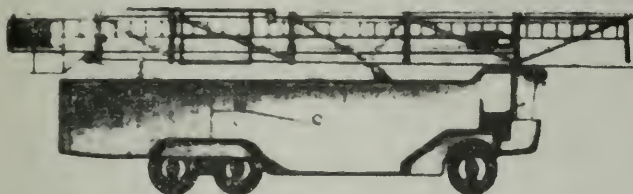
Waldrip Engineering Company, Los Angeles.

Check item 5 on postcard for more information.

From Oil and Gas Journal, May 10, 1947



(4) **PORTABLE SERVICING AND DRILLING RIG** provides easier, faster spotting by driving into well location nose first instead of backing in. New self-propelled rig services wells to 4,000 ft. and works over wells to 2,500 ft. It has a net hook horsepower of 117 and will start 4,000 ft. of 2½-in. tubing off bottom at 90 ft. per minute with three lines up. Unit is comprised of a double-drum hoist



with single-engine drive, torque converter or gear transmission, right-angle gear box, and portable telescoping derrick, all mounted on a streamlined six-wheel chassis. Functional design provides better balance and less weight, increasing speed of moving and erection. Power controls are placed at derrick leg for best operating vision. Motor at rear of unit is easily accessible, completely guarded by streamlined contour guards. Waldrip Engineering Co.

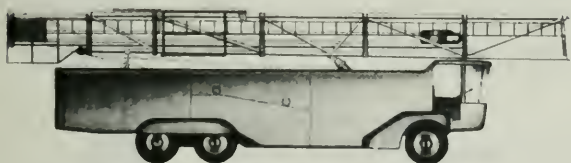


# Nose first

EXHIBIT 0



• THE WALDRIP "321" ASSURES FASTER SPOTTING AT WELL LOCATION because it is the ONLY self-propelled servicing and drilling rig that drives into the well location NOSE FIRST.



CHECK THESE OUTSTANDING FEATURES—Better balance with less weight  
 • Less load over front wheels • Clear operating vision • Easily accessible motor in rear • Unit completely guarded by smooth, streamlined contour, guards  
 • Furnished with gas, gasoline, butane or Diesel engine • Furnished with torque converter or gear box • Equipped with 65', 60,000 pound or 90,000 pound hook load capacity Waldrip telescoping derrick.

WRITE FOR DETAILS

## WALDRIP

### ENGINEERING COMPANY

MAIN OFFICE AND PLANT: 11810 CENTER STREET, HOLLYDALE, CALIFORNIA  
 San Joaquin Valley Division: 30th and M Sts., Bakersfield, Calif.







*Here it is!*

THE WALDRUP "321"—The only self-propelled servicing and drilling rig that drives into the location NOSE FIRST.

#### OUTSTANDING FEATURES

- Faster spotting at well location. • Better balance with less weight.
- Less load over front wheels. • Clear operating vision. • Easily accessible motor in rear. • Unit completely guarded by smooth, streamlined contour guards. • Furnished with gas, gasoline, butane or Diesel engine. • Furnished with torque converter or gear box.
- Equipped with 65', 60,000 = or 90,000 = hook load capacity Waldrup telescoping derrick.

WRITE FOR DETAILS

#### WALDRUP ENGINEERING COMPANY

11810 Center Street

Hollydale, California



EX 17 - EX - T

**PATENTED FILE**  
**TURN TO RECORD ROOM**  
 NUMBER (Serial of 1948)

**35666**

**PATENT NO. 1537**

**1948**

DATED **1934**  
 (EX'R'S BOOK) **123-10**

DIV. **33**

**JAMES MOON**

*to Western Oil & Gas Co. Inc. & its subsidiaries & assigns*

**ALT/DENA**

**CALIFORNIA**

**DERRICK MOUNTING FOR PORTABLE DRILLING AND SERVICING RIGS**

**ORIGINAL**

**APPLICATION FILED COMPLETE** **JUNE 28** **1948**

**Petition, Specification,**

**Oath, First Fee \$40** **JUNE 28** **1948**

**4** **sheets Drawings,**

**SETS OF APPLICATION FILED**

This is to certify that annexed hereto is a true copy from the records of the United States Patent Office of the file wrapper and contents of the file identified above.

By authority of the  
 COMMISSIONER OF PATENTS

**May 13, 1957**  
 Date

*Cliff Vanham Jr.*  
 Certifying Officer

Case No. **279 57 NM**

*Minn* vs. *Cal*

*Exhibit* EXHIBIT **T**

Date **MAR** NO. **T** IDENTIFICATION

Date **MAR** NO. **T** IN EVIDENCE

Clerk, U. S. District Court, Southern District of Cal.

*Chas. L. Ames* Deputy Clerk

PAT-80

RECEIVED ONLY  
THE COMMISSIONER OF PATENTS  
WASHINGTON 25, D. C.DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
WASHINGTON

Form No. 3

All communications respecting  
this application should give the  
serial number, date of filing,  
and name of the applicant.Please find below a communication from the EXAMINER  
in charge of this application.*Lawrence C. Kierse*  
Commissioner of Patents

OCT 18 1949

Philip Subkow  
435 Roosevelt Building  
Los Angeles 14, CaliforniaDivision: 33 - Room 5027  
Applicant: James MoonSer. No. 35,666  
Filed June 28, 1948  
For DERRICK MOUNTING FOR  
PORTABLE DRILLING AND SERVICING  
RIGS

This application has been examined.

Reference made of record:

McEwen et al. 2,331,553 Oct. 12, 1943 189-14

References of interest:

1 Dow	2,175,381	Oct. 10, 1939	189-14
2 Woody	2,204,716	June 18, 1940	189-11
3 Fleischmann	2,471,735	May 31, 1949	254-86
7 Donley et al.	2,251,013	July 29, 1941	255-19.1

Claims 1-5 are rejected as failing to patentably differ from the patent to McEwen et al. Applicant has merely taken McEwen's derrick structure and reversed the position, enclosing McEwen's standards (7) in the cab of the truck and causing the derrick to be raised forward of the truck rather than to the rear of the truck. Applicant's change of position is a matter of mechanical expedience and is not considered to involve invention.

*J. F. Thushake*  
Examiner

DMS/co

MAIL DIVISION

100-111

U. S. PATENT OFFICE

APR 11 1950

DIVISION 33

Div. 33  
Room 5087  
JAMES MOON  
DERRICK MOUNTING FOR PORTABLE  
DRILLING AND SERVICING RIGS  
Filed June 28, 1948  
Serial No. 35,666

Los Angeles, California, April 5, 1950

Hon. Commissioner of Patents  
Washington 25, D.C.

Sir:

In response to Office action dated October 18,  
1949, please amend the above-identified Application as  
follows:

Add the following new claim:

446. A portable drilling derrick, comprising  
a vehicle chassis, front and rear wheels for said chassis,  
the ends of the legs of said derrick protruding ahead of  
said front wheels and the top end of said derrick being  
positioned toward the rear of said chassis, a hinge on said  
derrick, said hinge being mounted at the front end of said  
chassis, and means positioned on said chassis to rotate said  
derrick about said hinge point to move said derrick to an  
erect position. \*\*\*

## REMARKS

The rejection is traversed.

The applicant, in reversing the position of the  
derrick so that the truck can drive head-on into position  
and need not back into position, has obtained advantages not  
possible with the cited prior art structures.

The McEwen reference is no different from the  
White Patent No. 2,204,713 cited at page 1, line 21, of the



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*End of*  
*B1*  
*C*  
*C*  
*In C*  
*7*

12. A portable drilling device comprising a truck chassis, <sup>*arrives*</sup> ~~the~~ <sup>*fixed*</sup> ~~cab~~ mounted on the front end of said chassis, front and rear axles for said truck, wheels mounted on said axles, standards mounted on said chassis and extending rearward from said cab ahead of said front axles, a derrick and a winch mounted on said standards, the top end of said derrick being pivoted toward the rear of said chassis, and means to rotate said derrick to an upright position <sup>*at the rear end*</sup> of said chassis.

*In C*  
*C*

13. A portable drilling device comprising a truck chassis, <sup>*arrives*</sup> ~~the~~ <sup>*fixed*</sup> ~~cab~~ mounted on the front end of said chassis, front and rear axles for said truck, wheels mounted on said axles, standards mounted on said chassis and extending rearward from said cab ahead of said front axles, a derrick and a winch mounted on said standards, the top end of said derrick being pivoted toward the rear of said chassis, and a cable drum mounted on said chassis and having a cable wound thereon, said cable being attached to the derrick and extending rearward of the latter, pointing said cable to the rear end of said chassis.

\*\*\*\*\*

14. A portable drilling device comprising a truck chassis, a derrick mounted on the front end of said chassis, front and rear axles for said truck, wheels mounted on said axles, standards mounted on said chassis and extending rearward from said derrick ahead of said front axles, a cable drum mounted on said chassis and having a cable wound thereon, said cable being attached to the derrick and extending rearward of the latter, pointing said cable to the rear end of said chassis.

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12. A portable drilling derrick comprising a truck chassis, a driver's cab fixedly mounted on the front end of said chassis front and rear axles for said truck, wheels mounted on said axles, standards mounted on said chassis and positioned in said cab ahead of said front axles, a derrick hingedly mounted on said standards, the top end of said derrick being positioned toward the rear of said chassis, and means to rotate said derrick to an upright position about the said hinge.

13. A portable drilling derrick comprising a truck chassis, a driver's cab fixedly mounted on the front end of said chassis front and rear axles for said truck, wheels mounted on said axles, standards mounted on said chassis and positioned in said cab ahead of said front axles, a derrick hingedly mounted on said standards, the top end of said derrick being positioned toward the rear of said chassis, and an extensible jack hingedly mounted on said chassis at a point rearward of said front axles, said jack being hingedly mounted on said derrick at a point rearward of the hinge point of said jack to said chassis. - - -

## REMARKS

The above claims are believed patentable for the reasons advanced in the amendment dated April 5, 1950. Each of said claims is directed to the feature whereby the derrick may be driven onto the job head-on. Each of the claims calls for the top end of the derrick to be positioned toward the rear of the chassis. This is in contradistinction to the prior art in which the top of the derrick is positioned toward the front end of the chassis.

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The claims differ from the claims in the case in omitting the specific recitation of the provision of the ends of the legs of the derrick. It is believed that the applicant is entitled to claims which in scope will cover the use of removable legs or other expedients to avoid the language of the claims while employing the essence of the invention. While it may be true that the original claims may cover such variation under the doctrine of equivalence, applicant, it is believed, is entitled to claims in language broad enough to cover this variation without resort to that doctrine.

Respectfully

*Philip Surkov*  
Philip Surkov  
attorney for applicant

PC:AC

Ser. 35,666 - - - - - 4

The claims differ from the claims in the case in omitting the specific recitation of the provision of the ends of the legs of the derrick. It is believed that the applicant is entitled to claims which in scope will cover the use of removable legs or other expedients to avoid the language of the claims while employing the essence of the invention. While it may be true that the original claims may cover such variation under the doctrine of equivalence, applicant, it is believed, is entitled to claims in language broad enough to cover this variation without resort to that doctrine.

Respectfully

PHILIP SUBKOW

Philip Subkow

Attorney for Applicant

PS:EC

POL-40

ATTORNEY ONLY  
THE COMMISSIONER OF PATENTS  
WASHINGTON 25, D. C.

DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
WASHINGTON

Paper No. 7

All communications regarding  
this application should give the  
serial number, date of filing,  
and name of the applicant.

Please find below a communication from the EXAMINER  
in charge of this application.

Philip Subkow  
800 Roosevelt Building  
Los Angeles 14, Calif.

*John A. Marshall*

Commissioner of Patents.

Division: 33  
Applicant: James Moon

Ser. No. 35,566  
Filed June 26, 1948  
For DERRICK MOUNTING  
FOR PORTABLE  
DRILLING AND  
SERVICING RIGS

JAN 31 1951

Responsive to the amendments filed

April 10, 1950 and June 22, 1950.

Additional references applied to the claims:

✓ Preston	414,574	Nov. 5, 1889	228-6
✓ Steck	377,424	Mar. 13, 1886	228-6
✓ Kim	443,094	Dec. 23, 1890	228-6
✓ Haines	855,771	June 4, 1907	228-8
✓ Fiedler	2,496,706	Feb. 7, 1950	61-74
	(Filed Aug. 2, 1946)		

On page 5, lines 15 and 22 and in

Figures 1 and 3, character "25" has been used to  
denote two different elements.

Claims 1, 3, 4, 6 to 9, 11 and 12 are  
rejected as substantially met by the patent to  
Fiedler. The Fiedler patent discloses a wheeled  
vehicle having a derrick hinged at a location for-  
ward of the front wheels and means to raise said  
derrick member. Provision of a cab at the forward  
end of the Fiedler vehicle is deemed to involve no  
invention.

Claims 1, 3, 4, 6 to 9, 11 and 12 are  
further rejected as unpatentable over the patent to  
Kim or Steck or Preston, cited above, in view of

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- 2 -

McEwen et al., of record. It would involve no invention to substitute a derrick member, for example, as taught by McEwen et al., for the ladder members disclosed by either Kim or Steck or Preston, or to provide the ladder trucks with a cab at the forward end.

Claims 2, 5, 10 and 13 are rejected as unpatentable over Fiedler in view of Haines. In addition to the remarks set forth in the rejection of claims 1, 3, 4, 6 to 9, 11 and 12, it would involve no invention to substitute the jack means of Haines for the derrick hoisting means of Fiedler.

Claims 2, 5, 10 and 13 are further rejected as unpatentable over Kim or Steck or Preston, taken with McEwen et al., in view of Haines. In addition to the remarks set forth in the rejection of claims 1, 3, 4, 6 to 9, 11 and 12, it would involve no invention to substitute the jack means of Haines for the derrick erecting mechanism disclosed by either Kim, Steck or Preston.

Claims 1 to 13, inclusive, are rejected.

EJH:rp

*M. J. Throckmole*  
Examiner



Serial No. 35,666

- 2 -

McEwen et al., of record. It would involve no invention to substitute a derrick member, for example, as taught by McEwen et al., for the ladder members disclosed by either Kim or Steck or Preston, or to provide the ladder trucks with a cab at the forward end.

Claims 2, 5, 10 and 13 are rejected as unpatentable over Fiedler in view of Haines. In addition to the remarks set-forth in the rejection of claims 1, 3, 4, 6 to 9, 11 and 12, it would involve no invention to substitute the jack means of Haines for the derrick hoisting means of Fiedler.

Claims 2, 5, 10 and 13 are further rejected as unpatentable over Kim or Steck or Preston, taken with McEwen et al., in view of Haines. In addition to the remarks set-forth in the rejection of claims 1, 3, 4, 6 to 9, 11 and 12, it would involve no invention to substitute the jack means of Haines for the Derrick erecting mechanisms disclosed by either Kim, Steck or Preston.

Claims 1 to 13, inclusive, are rejected.

W. J. MUSHAKE

EGH:rp

Examiner

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1944-1945

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1944-1945

1944-1945

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end of the vehicle.

(This also distinguishes from Fiedler, McEwan and Woody)

All the claims are limited to the fixedly positioning of the cab in the chassis. All claims recite the cab and the controls in the cab and the adjacent mounting of the derrick hinge point.

This should distinguish claims 1, 3, 4, 6 to 9, 11 and 12 from Fiedler, and from Kim or Steck or Preston even when taken with McEwan, et al.

This should also distinguish claims 2, 5, 10 and 13 from Fiedler in view of Haines, since the basic reference fails to meet the claims, or Kim or Steck or Preston taken with McEwan et al in view of Haines.

Simply stated, the idea of pivoting the rear end of the derrick adjacent the cab, so that the driver can drive into location and see the derrick legs as they move into position on the ground, is not shown by the prior art. Applicant's device does this; the prior art does not.

Reconsideration and allowance of all the claims are requested.

Respectfully

PHILIP SUBKOW

Philip Subkow

Attorney for Applicant

PS:EC



Responsive to amendment filed July 30, 1951.

Additional references applied to the claims:

Luckett	2,406,620	Aug. 27, 1946	212-8
Deist	2,315,942	Apr. 6, 1943	212-8

Additional reference of interest:

Cornett	2,335,172	Nov. 23, 1943	255-51V
---------	-----------	---------------	---------

Claims 1-5 and 7-13 are rejected on the ground of multiplicity. The large number of claims presented provides for no material benefit to the applicant but merely tends to confuse and obscure the invention, if any. The number of claims can be greatly reduced to perhaps one without sacrificing scope, clarity or protection. Further, the claims, as presented, are not patentably distinguishable over each other. For example, claim 8 differs from claim 7 only by reciting that the rotating means is mounted on the chassis, however this slight difference is not considered to lend any patentable merit to the claim. See *In re Spencer* 407 O.G. 861.

Claims 1-5 and 7-13 are further rejected as unpatentable over *Donley et al* or *Luckett* in view of *McEwen et al*. The *McEwen et al* patent discloses a portable derrick 10

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-2-

hinged to standard 7 and elevated by the hydraulic means 22 which is pivotally mounted to the trailer 2 by the pivot 21. The pivot 21 of the hydraulic means 22 and theerrick hinge are each disposed on opposite sides of the trailer wheel axes. The applicant's structure differs from the prior art structure merely by pivoting theerrick at the front end of a truck to enable easier location of theerrick bottom at the drilling site. The contents of Dunley et al and Luckett, respectively disclose a tower and boom pivotally secured to the front end of a truck. Applicant is urged to read care one of the Dunley et al specification which sets forth the particular advantages of pivoting the tower 115 at the front end of the truck. Providing either the Dunley et al or the Luckett structures with theerrick, standards and hydraulic relative means of McEwen/in lieu of the tower and boom structure and their respective elevating means disclosed by Dunley et al and Luckett is not considered to involve inventive merit/as warrant allowance. Locating theerrick hinge and the lower pivot of the hydraulic means forwardly and rearwardly respectively of the front wheels is fully taught by McEwen et al. Should it be desired to locate theerrick hinge over the vehicle end, for example as disclosed by Wist, such provision would entail mere mechanical skill.

Applicant should prepare this case for final action by his next amendment.

Claims 1-5 and 7-13 are rejected.

*E. D. H.*  
Examiner

*E. D. H.*  
Examiner

43

35666



Serial No. 35,666

-2-

hinged to standards 7 and elevated by the hydraulic means 22 which is pivotally mounted to the trailer 2 by the pivot 21. The pivot 21 of the hydraulic means 22 and the derrick hinge are each disposed on opposite sides of the trailer wheel axles. The applicant's structure differs from the McEwen et al structure merely by pivoting the derrick at the front end of a truck to enable easier locating of the derrick bottom at the drilling site. The patents to Donley et al and Luckett, respectively disclose a tower and boom pivotally secured to the front end of a truck. Applicant is urged to read page one of the Donley et al specification which sets forth the particular advantages of pivoting the tower 145 at the front end of the truck. Providing either the Donley et al or the Luckett structures with the derrick, standards and hydraulic rotative means of McEwen et al in lieu of the tower and boom structure and their respective elevating means disclosed by Donley et al and Luckett is not considered to involve inventive merit as to warrant allowance. Locating the derrick hinge and the lower pivot of the hydraulic means forwardly and rearwardly respectively of the front wheels is fully taught by McEwen et al. Should it be desired to locate the derrick hinge over the vehicle cab, for example as disclosed by Deist, such provision would entail mere mechanical skill.

Applicant should prepare this case for final action by his next amendment.

Claims 1-5 and 7-13 are rejected.

W. J. MUSHAKE

EGH:tah

Examiner

End 4  
B1  
Ser. 35,666 -----5

bearing away from said truck at an acute angle to the vertical when said derrick is in ~~an~~ erect position. 1-44

### R E M A R K S

The applicant wishes to express his appreciation for an oral interview had with the Examiner in February of 1952, prior to the issuance of the last Office action. At that time the references in the case were discussed, proposed claims were informally submitted, and the Examiner indicated that a claim similar to new claim 14 would be, in his view, favorably considered if presented. One of the features which the Examiner indicated as possibly carrying the claim over the then cited references was the straddling of the cab by the derrick when erected. It is respectfully urged that the new references do not in any way meet this claim, either alone or in combination with the cited references. The additional claims 15 to 17 are likewise patentable.

#### The rejection:

Applicant understands the rejection to be as follows:

(1) McEwen shows an oil derrick of the same class as is used by applicant.

(2) Derricks have been mounted on trucks so that they are hinged at the front end of the truck and Donley points out that in so doing the driver can drive directly to the spot where he wishes to erect the derrick. Derricks have been hinged on the top of the cab of cranes (Leist); and that

(3) Therefore, there is no invention in doing the same thing in the McEwen derrick, and no invention in hinging the derrick on the front of the derrick and over the cab.

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bearing away from said truck at an acute angle to the vertical when said derrick is in an erect position.

### REMARKS

The applicant wishes to express his appreciation for an oral interview had with the Examiner in February of 1952, prior to the issuance of the last Office action. At that time the references in the case were discussed, proposed claims were informally submitted, and the Examiner indicated that a claim similar to new claim 14 would be, in his view, favorably considered if presented. One of the features which the Examiner indicated as possibly carrying the claim over the then cited references was the straddling of the cab by the derrick when erected. It is respectfully urged that the new references do not in any way meet this claim, either alone or in combination with the cited references. The additional claims 15 to 17 are likewise patentable.

The rejection:

Applicant understands the rejection to be as follows:

(1) McEwen shows an oil derrick of the same class as is used by applicant.

(2) Derricks have been mounted on trucks so that they are hinged at the front of the truck and Donley points out that in so doing the driver can drive directly to the spot where he wishes to erect the derrick. Derricks have been hinged on the top of the cab of cranes (Deist); and that

(3) Therefore, there is no invention in doing the same thing in the McEwen derrick, and no invention in hinging the derrick on the front of the derrick and over the cab.

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this application should give the  
serial number, date of filing,  
and name of the applicant.

Form No. 12

Philip Subkow  
800 Roosevelt Bldg.  
Los Angeles 11, Calif.Please find below a communication from the  
EXAMINER in charge of this application.*James H. Hargrave*  
Commissioner of Patents*Robert C. Hargrave*

Applicant:

James Hargrave

Ser. No.  
35,666Filed  
June 28, 1948For  
DERRICK MOUNTING FOR  
PORTABLE DRILLING AND  
SERVICING RIGS

MAILED

MAY 28 1952

PAT.  
DIV. 33

Responsive to amendment filed September 16, 1952.

Claims 14, 15 and 17 are rejected as being functional. The statement "the legs...extended position", appearing in the last two lines of claim 14 and the last three lines of claim 15 and the phrase "the width...erect position" in lines 10-21 of claim 17 are believed to recite a desired result without the inclusion of sufficient structure enable one performing such result. The claims should specifically set forth the particular width relationship of the derrick legs and the cab and also the location of the cross-bracing elements so as to indicate that said derrick legs will straddle the cab without interference with said cab or cross-bracing.

Claims 16-17 are rejected as being indefinite. In line 1 of each of the claims the term --consisting of-- should be inserted after "serviced". In claim 16, line 3 "in" should read --on-- and in lines 21 and 22, the phrase "the front legs of said chassis" appears to be incorrect insofar as the chassis is on front legs. The rear legs of the service, as set forth in the specification, and not the front legs, as stated in line 17 of claim 17, straddle the cab.

Claim 16 is rejected as unobtainable over Kelley et al in respect to view of claim 16, 1948, 2nd div. The

Responsive to amendment filed September 18, 1952.

Claims 14, 15 and 17 are rejected as being functional. The statement "the legs . . . . extended position", appearing in the last two lines of claim 14 and the last three lines of claim 15 and the phrase "the width . . . . . erect position" in lines 18-21 of claim 17 are believed to recite a desired result without the inclusion of sufficient structure capable of performing such result. The claims should specifically set forth the particular width relationship of the derrick legs and the cab and also the location of the cross-bracing elements so as to indicate that said derrick legs will straddle the cab without interference with said cab or cross-bracing.

Claims 14-17 are rejected as being indefinite. In line 1 of each of the claims the term—consisting of—should be inserted after "derrick". In claim 15, line 6 "in" should read—on—and in lines 23 and 24, the phrase "the front legs of said chassis" appears to be incorrect insofar as the chassis has no front legs. The rear legs of the derrick, as set forth in the specification, and not the front legs, as stated in line 19 of claim 17, straddle the cab.

Claim 16 is rejected as unpatentable over Donley et al or Luckett in view of McEwen et al, all of record. The





Ser. No. 35,666

- 2 -

Donley et al and Luckett patents each disclose a structure having a chassis having rear and front wheels, a drivers cab at the front end of the chassis, a boom or tower structure pivotally mounted at the front end of said chassis and boom or tower actuating means. Substituting the McEwen et al derrick member and elevating means for the boom or tower means of Donley et al or Luckett is deemed to entail no inventive skill as to warrant allowance. Pivotaly securing the substituted derrick of McEwen et al on the top of the Donley et al or Luckett cab is believed to provide for no new or unobvious results as to lend patentable significance to the claim and is believed to be well within the purview of the skilled artisan.

Upon satisfactory correction of claims 14, 15 and 17 along the lines indicated above, such claims will appear to be allowable.

An issue having been reached, this action is most

FINAL.

*EDH*  
EDH:lfs

*W.D. Shushak*  
Examiner

Serial No. 35,666-----#5

The present amendment includes two changes overlooked at the above-mentioned interview. In claim 19, line 36, "lower" is cancelled since the antecedent for "said leg portions" at line 34 does not include "lower". In claim 20, lines 36 and 37, "the portion of . . . to the ground" is changed to "a lowermost portion of the derrick". This change is made because it more accurately coincides with the disclosure. These changes remain wholly within the spirit of the understanding reached at the conference.

Claim 22 is allowable because it is similar to claim 19 and recites structure which lends patentability to the claims. Claim 22 is directed to a collapsible and extensible portable derrick hingedly mounted upon a mobile chassis for erection adjacent the front end of the chassis. It further defines means for placing the derrick legs in load transference relationship with the ground; and defines the relative location of parts placing one pair of front and rear derrick legs with their respective load transference means to one side of the driver's position, and the other pair of front and rear derrick legs with their respective load transference means to the other side of the driver's position, with the derrick in erect position. This claim further carries the added specific limitation over claim 19 of placing the motive power unit in the rear of the chassis.

Serial No. 35,666        -        -        -        -        -        -        #5

The present amendment includes two changes overlooked at the above-mentioned interview. In claim 19, line 38, "lower" is cancelled since the antecedent for "said leg portions" at line 34 does not include "lower". In claim 20, lines 36 and 37, "the portion of . . . to the ground" is changed to "a lowermost portion of the derrick". This change is made because it more accurately coincides with the disclosure. These changes remain wholly within the spirit of the understanding reached at the conference.

Claim 22 is allowable because it is similar to claim 19 and recites structure which lends patentability to the claims. Claim 22 is directed to a collapsible and extensible portable derrick hingedly mounted upon a mobile chassis for erection adjacent the front end of the chassis. It further defines means for placing the derrick legs in load transference relationship with the ground; and defines the relative location of parts placing one pair of front and rear derrick legs with their respective load transference means to one side of the driver's position, and the other pair of front and rear derrick legs with their respective load transference means to the other side of the driver's position, with the derrick in erect position. This claim further carries the added specific limitation over claim 19 of placing the motive power unit in the rear of the chassis.

